

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-3, 10, 11, 17, 22, 23 and 26 are rejected under 35 USC 103(a) over the U.S. patent to Raines.

Claims 4-5, 7 and 8 are rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patent to Trott.

Claims 6 and 25 are rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patent to Trott.

Claim 14 is rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the patent to Hutchins.

Claims 15-16 are rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the patent to Jasch.

Claims 18, 19 and 20 are rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patent to Goris.

Claim 21 is rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patent to Goris.

Claim 24 is rejected under 35 USC 103(a) over the U.S. patent to Raines.

Claims 27-29 are rejected under 35 USC 103(a) over the U.S. patent to Raines.

Claim 30 is rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patent to Goris.

Claim 31 is rejected under 35 USC 103(a) over the U.S. patent to Raines in view of the U.S. patents to Goris and Jasch.

After carefully considering the Examiner's grounds for rejection of the claims, applicant amended Claim 1, the broadest claim on file, to correct a typing error. Also, Claim 23 has been cancelled.

The Examiner's grounds for rejection of the claims over the art have been carefully considered. In connection with this, applicant wishes to make the following remarks.

Claim 1 defines the device comprising a centering element (10) and at least one form-locking element (12) for fastening an axially mountable tool drivable in an oscillating manner to a drive shaft of a hand-held power tool. As defined in particular in Claim 1, with the form-locking element (12) located radially outside the centering element (10), the radius associated with one position of the form-locking element (12) is four times as large as a radius of the centering element. This feature provides a stable form-locking fastening in a circumferential direction which is compact and adequate for absorbing forces exerted in oscillatingly drivable tools of a hand-held power tool during the operation. In the attached Declaration of Facts, the inventor specifically explains the highly advantages results provided by this feature confirming that the present invention is new, unobvious, highly advantageous and patentable over the patent to Raines, which does not provide any hint or suggestion for this feature.

Claim 27 defines the above-mentioned device in which more than eight form-locking elements are arranged radially outside the centering element. With this feature, in particular forces exerted on oscillatingly drivable tools during a heavy-duty operation can be safely absorbed by a bearing flange of the power tool without damaging the tool or the bearing flange. This is also specifically explained in the above mentioned Declaration of Facts, which clearly shows that the present invention as defined in Claim 27 is new, highly advantageous, unobvious and patentable over the patent to Raines, which does not disclose this particular feature and does not provide any hint, suggestion, or motivation for it.

Claim 18 defines the tool with a centering element (10) and a form-locking element (12') for axial mounting and fastening onto a drive shaft of a hand-held tool drivable in oscillating manner of a hand-held power tool, wherein the form-locking element has a rectangular cross section. With the quadrangular cross section, forces can be transferred effectively to the bearing flange in a circumferential and a radial direction. Neither the patent to Raines nor the patent to Goris disclose these features. As specified in the attached Declaration of Facts, this feature provides for highly advantageous unobvious results, and therefore the tool defined in Claim 18 should be considered new, highly advantageous, unobvious and patentable over the patents to Raines and Goris taken singly or in combination with one another.

Finally, Claim 30 defines the above mentioned tool in which the centering element and the form-locking element are arranged in the first tool part which is parallel to a second tool part connected to the first tool part via an inclined section. This makes construction space available with the use of the inclined section between the tool and the hand-held power tool. The patents to Raines and Goris do not disclose these features of the present invention. As specified in the attached Declaration of Facts, the tool defined in Claim 30 should be considered as new, highly advantageous, unobvious and patentable over these references.

The Examiner rejected the above mentioned claims over the patent to Raines taken singly or in combination with the patent to Goris as being obvious under 35 USC 103(a). As explained hereinabove, the present invention as defined in the

above listed independent claims is not disclosed in the references, and the references contain no hint, suggestion, or motivation for these features.

In order to arrive at the applicant's invention as defined in the above mentioned Claims 1, 27, 18 and 30, the references have to be fundamentally modified by including into them the new features of the present invention which are not disclosed in the references and which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained hereinabove, the present invention as defined in the above mentioned independent claims provides for the highly advantageous results which cannot be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, and the facts submitted in the Declaration of Facts, it is respectfully submitted that Claims 1, 27, 18 and 30 should be considered as patentably distinguishing over the art and should be allowed.

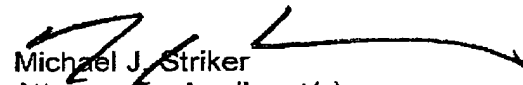
As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion

might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


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